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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,557	10/25/1999	WERNER BERGER	BERGER	7441

30008 7590 08/28/2003

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23  
EXAMINER

RAJGURU, UMAKANT K

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/403,557

Applicant(s)

BERGER ET AL.

Examiner

Umakant K. Rajguru

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 35-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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1. An RCE (paper 20) and a preliminary amendment (paper 21) have been filed on May 27, 2003.
2. Claims 35-57 are under examination.
3. The previous rejections of claims 18-34 are moot since those claims are now cancelled.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 35-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter (WO 96/37544) in view of Krishnan et al (US 5500465).

(Both references have been cited in earlier office actions).

Please refer to paper 15 for this rejection (which was applied to cancelled claims 18-34).

On page 3 (of above paper 21), the applicants' argument that prior art viz Ritter, uses water glass in dry powder form and not as solution (as in instant claims) is not persuasive because the powder used by Ritter is going to be mixed in water and form a solution.

Applicants' next argument (on same page) that "the compounds in the reaction mixture of instant invention are allowed to react for an extended period etc" is also not persuasive because instant claims do not encompass any time-based limitation and the applicants have not provided any evidence in support of this argument.

Applicants' next argument that "Ritter uses water glass as a filler (not as a reactive component)" is not convincing since even if water glass is used as a filler it is

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likely that said water glass may react unless proved otherwise. Additionally it is immaterial whether an ingredient of a composition is named in the prior art as a filler or as some other material.

The rough surface of the product in example 1 of Ritter can not conclusively be ascribed to the presence of filler alone.

Applicants' next arguments (on page 4) about the short reaction time in prior art versus long time in instant invention are not persuasive since (a) (as stated earlier) instant claims do not encompass this limitation and (b) there is no evidence from the applicants to support their arguments.

Applicants' statement (on page 5) that "Ritter does not suggest presaponification" is not convincing because, though not stated expressly in Ritter, the (claimed) presaponification is inherently suggested therein because of mixing of acetate and alkali.

Applicants' remaining arguments on page 5, based on water content and pH as being other than those that are instantly claimed are also not persuasive because it is within one's expertise to vary these values in order to produce an expected end product.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. K. Rajguru whose telephone number is 703-308-3224. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 703-308-2462. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



U. K. Rajguru/mn  
August 25, 2003



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700